

## REMARKS

This Reply is in response to the Final Office Action mailed on April 22, 2005 in which Claims 64-71 were allowed; in which Claims 41-43, 49, 53, 62 and 63 were objected to; and in which Claims 29, 31, 32, 34-40, 44-48, 50-52, 54, 55 and 58-61 were rejected. With this response, Claim 34 is cancelled and Claims 39-41 are amended. Claims 29, 31, 32, 35-55 and 58-71 are presented for reconsideration and allowance.

### I. Examiner Interview Summary

On April 5 and April 7, telephonic interviews were held between Examiner Liang and Applicant's attorney, Todd A. Rathe. The Examiner indicated that a further search had resulted in identification of new art including Silverbrook, et al., U.S. Patent No. 6,628,430, and Miyamoto, et al., Japanese Patent 2000-184911. Although claims 29, 31, 55 and 59 were discussed, no agreement was reached. Applicant wishes to thank Examiner Liang for the opportunity to discuss such newly discovered references and their asserted relevance to the claims.

### II. Claim Objections.

Page 2 of the Office Action objected to Claims 34-35 and 39-41 noting several informalities. In response, Claims 34 is cancelled. Each of claims 39-41 are amended to correct the grammatical errors noted in such claims. Because such amendments merely address technical objections and do not raise new issues, entry of such amendments is requested. In light of such amendments, Applicant requests that the objections be withdrawn.

### III. Rejection of Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 under 35 U.S.C. § 103 Based Upon Silverbrook '430 and Miyamoto.

Page 3 of the Office Action rejected Claims 29, 31-32, 34-40, 44, 54, 58-59 and 61 under 35 U.S.C. § 103 as being unpatentable over Silverbrook et al., U.S. Patent No. 6,628,430, in view of Miyamoto, et al., Japanese Patent 2000-184911. As noted above, Claim 34 is cancelled to overcome a technical objection. In light of

the following remarks, Applicant respectfully requests that the Examiner withdraw the rejection of Claims 29, 31-32, 35-40, 44, 54, 58-59 and 61 based upon Silverbrook '430 and Miyamota.

A. Claims 29, 58 and 59.

Independent Claims 29 and 58 each recite a media processing device which includes a media processing engine having a media input along an external face of the device and a media output opposite the external input, wherein the engine is coupled to a structure by a support such that the media output is below an uppermost extremity of the vertical surface and such the media input receives media while the media is in a vertical orientation. Similarly, independent Claim 59 recites a method for processing media in which a device is supported along a vertical surface and in which media is fed through a media input along an external face of the device to an engine while the media is substantially vertical.

Neither Silverbrook '430 nor Miyamota, alone or in combination, disclose or suggest a media processing device or a method for processing media wherein the device is supported along a vertical surface and where media is fed through a media input along an external face of the device to an engine while the media is substantially vertical and is discharged from an external media output opposite the media input. The Office Action acknowledges that Silverbrook '430 fails to disclose a support coupled to the engine and configured to couple the engine to the structure such that the media output is below the uppermost extremity of a vertical surface. (Office Action, pp. 4-5 – discussing Claim 29 and p. 5 – discussing Claims 58 and 59.) As a result, in its rejection of Claims 29, 58 and 59, the Examiner attempts to additionally rely upon Miyamota. The Office Action asserts that Miyamota discloses a support configured to couple an engine to a vertical structure. The Office Action further asserts that it would be obvious to incorporate the teaching of Miyamota into the invention of Silverbrook '430 “to gain the benefit of providing a vertical supporting means for the media processing device, so that it does not have to be held in the hand all the time.” (Office Action, p. 6.)

However, in contrast to the assertion made in the Office Action, it would not be obvious to one of ordinary skill in the art to modify the mobile phone of Silverbrook '430 to additionally include the support disclosed by Miyamota since such a modification would destroy the intended function of the mobile phone of Miyamota or of the phone of Silverbrook '430 or would require a complete redesign of the support disclosed by Miyamota. It is a well known law that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. (See MPEP 2143.01 THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE.)

In the present case, one of the intended purposes of the mobile phone of Silverbrook is to provide an integral internal printer. In particular, Silverbrook discloses a printer phone 1 in which print media 30 is fed through an entry slot 31 located on a side of printer phone 1. Miyamota discloses a portable telephone holder 1 which requires a pair of spaced belts 3 to retain the portable telephone 4 on holder 1. To modify printer phone 1 of Silverbrook to additionally include telephone holder 1 would render printer phone 1 unsatisfactory for its intended purpose, printing. In particular, belts 3 of Miyamota would necessarily extend across slot 31 and interfere with or obstruct inputting of media into slot 31. Miyamota specifically discloses belts 3 as extending across a central portion of phone 1 across its keypad. To similarly position belts 3 across the keypad of Silverbrook would result in belts 3 extending across and obstructing inputs slot 31 of Silverbrook.

Moreover, no teaching or suggestion exists for alternately modifying the location of belts 3 of Miyamota or omitting belts 3. Belts 3 of Miyamota are presumably located at their disclosed locations so as to not interfere with the display of the cell phone and so as to accommodate different cell phones having different lengths. To reposition the uppermost belt 3 would result in the belt 3 obstructing the display of the cell phone or may result in holder 1 not being able to accommodate differently sized cell phones. Moreover, as clear from drawing 3 of Miyamota, such belts are required to retain the cell phone in place and to prevent the cell phone from

falling off of legs 19. Thus, it would not be obvious to additionally modify the location of belts 3 or to omit belts 3. Thus, the hypothetical combination of Silverbrook and Miyamoto as proposed in the Office Action would either render unsatisfactory the intended purpose of Silverbrook, printing, or would render unsatisfactory the intended purpose of Miyamoto, securely retaining and supporting a cell phone. Accordingly, the rejection of Claims 29, 58 and 59 based upon the hypothetical combination of Silverbrook and Miyamoto would appear to be based solely upon impermissible hindsight reasoning. Applicant respectfully requests that the rejection of independent Claims 29, 58 and 59 be withdrawn.

B. Claim 31.

Claim 31 depends from Claim 29 and further recites that the device, when vertically oriented, has a height, a width and depth, wherein the first face and the second face each define the width and the depth of the engine and wherein the depth is smaller than the height and the width. In other words, because the media input and the media output are provided in the first face and the second face, respectively, Claim 31 is directed to the device of Claim 29 wherein movement of media through the engine is along a generally vertical or top-to-bottom path.

Neither Silverbrook '430 nor Miyamoto, alone or in combination, disclose or suggest a media processing device wherein the device, when vertically oriented, has a height, a width and a depth, wherein the first face, along which the media input extends, and the second face, along which the media output extends, each define the width and the depth of the engine. Neither Silverbrook '430 nor Miyamoto disclose a media processing device in which the media input and the media output are located along external faces such that media moves along a substantially vertical or top to bottom path. In contrast, Miyamoto fails to disclose any media input or media output. Silverbrook '430 merely discloses an entry slot 31 which facilitates side-to-side feeding of media, not vertical or top-to-bottom feeding of media.

The Office Action apparently acknowledges this deficiency of Silverbrook '430. In particular, in its rejection of the claims, the Office Action states:

NOTE: For purposes of this rejection figure 1 of Silverbrook, et al. will be viewed in an orientation 90° to the orientation shown in the figure. The reoriented figure 1 is shown below.

(Office Action, p. 2.)

The Office Action fails to provide any support, motivation or suggestion for reorienting printer phone 1 of Silverbrook '430 other than the teachings found in Applicant's own disclosure. Such hindsight in view of Applicant's own disclosure is impermissible.

Moreover, as acknowledged in the Office Action, Silverbrook still fails to disclose a support to couple the media processing engine of Silverbrook, et al., to a vertical structure. Even assuming, arguendo, that it would be obvious to modify the printer phone 1 of Silverbrook, et al., to additionally include the portable telephone holder 1 of Miyamoto, the hypothetical combination would result in printer phone 1 of Silverbrook '430 being supported in the same orientation as shown in figure 1 of Silverbrook '430 and also in the same orientation as shown in drawing 1 of Miyamoto. In the orientation shown in figure 1 of both Silverbrook '430 and Miyamoto, the first face along which the media input extends and the second face along which the media output extends would not define the width and depth of the engine. In the orientation illustrated in Figure 1 of both Silverbrook '430 and Miyamoto, media would have to be fed through the cell phone along a horizontal or side-to-side path rather than a vertical top-to-bottom path.

Neither Silverbrook '430 nor Miyamoto provide any motivation or suggestion for alternatively connecting portable telephone holder 1 of Miyamoto to printer phone 1 of Silverbrook '430 in an alternative orientation other than that shown in drawing 1 of Miyamoto. Neither Silverbrook '430 nor Miyamoto provide any motivation or suggestion for reconfiguring portable telephone holder 1 to alternatively support a cell phone in a sideways horizontal orientation. In fact, one of ordinary skill in the art would seemingly be led away from such a modification in that both the screen or display of the cell phone and the keypad of the cell phone would also need to be

retained in sideways orientation, making the reading of text on the display or the reading and entry of data through the keyboard of the cell phone difficult. Because the Office Action has failed to cite any motivation or suggestion for (1) reorienting printer phone 1 of Silverbrook 90° or (2) somehow reconfiguring the telephone holder of 1 of Miyamoto to also support the printer phone 1 of Silverbrook '430 in the reoriented position, the rejection of Claim 31 based upon Silverbrook '430 and Miyamoto appears to be improper as using Applicant's own disclosure as a blueprint for such a modification. Accordingly, Applicant respectfully requests that the rejection of Claim 31 be withdrawn for this additional reason.

C. Claim 61.

Claim 61 depends from Claim 59 and recites a further step of holding ejected media below the media output.

Neither Silverbrook '430 nor Miyamoto disclose or suggest the step of holding ejected media below the media output. Even assuming, arguendo, it would be obvious to modify the printer phone 1 of Silverbrook '430 to somehow include the telephone holder 1 of Miyamoto, the hypothetical combination would still fail to disclose any structure for facilitating the step of holding the ejected media below the media output. Even assuming, arguendo, that there was a suggestion to add a media holder to the hypothetical combination of Silverbrook '430 and Miyamoto, such a holder would not hold ejected media below the media output since media is discharged sideways from the printer phone 1 of Silverbrook '430. Accordingly, Applicant requests that the rejection of Claim 61 be withdrawn for this additional reason.

IV. Rejection of Claims 45-46 based upon Silverbrook '430, Miyamoto and Khormaeel.

Page 7 of the Office Action rejected claims 45-46 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook, et al., U.S. Patent No. 6,628,430 in view of Miyamoto, et al., Japanese Patent 2000-184,911 and further in view of Khormaeel,

U.S. Patent No. 5,397,192. Applicant respectfully requests that the rejection of Claims 45 and 46 be withdrawn.

Claim 45 depends from Claim 29 and recites that the media input is configured to receive media having a width of at least 8 inches.

The Office Action acknowledges that Silverbrook '430 fails to disclose a media input configured to receive media having a width of at least 8 inches. As a result, the Office Action attempts to additionally rely upon Khormaee which indicates a common recording media may include standard 8.5 x 11 inch paper. However, the Office Action has failed to cite any motivation or suggestion for modifying entry slot 31 of the printer phone 1 of Silverbrook '430 to have a width of at least 8 inches. One of ordinary skill in the art would not be led to reconfigure printer phone 1 of Silverbrook such that its entry slot 31 has a dimension of at least 8 inches. The title itself of Silverbrook '430 recites that the phone is to "hand held" and "mobile". Enlarging printer phone 1 of Silverbrook '430 such that entry slot 31 has a dimension of at least 8 inches would destroy the intended function of printer phone as being a handheld mobile phone. Common sense dictates against such a hypothetical modification of Silverbrook '430. Accordingly, Applicant respectfully requests that the rejection of Claim 45 based upon Silverbrook '430, Miyamoto and Khormaee be withdrawn. Claim 46 depends from Claim. Thus, Applicant respectfully requests that the rejection of Claim 46 also be withdrawn.

V. Rejection of Claim 47 under 35 U.S.C. § 103 based upon Silverbrook '430, Miyamoto and Kikuchi.

Page 8 of the Office Action rejected Claim 47 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook, et al., U.S. Patent No. 6,628,430 in view of Miyamoto, et al., Japanese Patent 2000-184,911 and further in view of Kikuchi, U.S. Patent No. 5,929,894. Claim 47 depends from Claim 29 and overcomes the rejection for the same reasons discussed above with respect to claim 29.

VI. Rejection of Claims 48, 50-52, 55 and 60 based upon Silverbrook '430, Miyamoto and Silverbrook '349.

Pages 8 and 9 of the Office Action rejected Claims 48, 50-52, 55 and 60 under 35 U.S.C. § 103(a) as being unpatentable over Silverbrook, et al., U.S. Patent No. 6,628,430 in view of Miyamoto, et al., Japanese Patent 2000-184,911 and further in view of Silverbrook, et al., U.S. Patent No. 6,290,349. Applicant respectfully requests that the rejection of Claims 51-52, 55 and 60 be withdrawn.

A. Claim 51

Claim 51 depends from Claim 50 and recites a receiver which receives media from the media output as configured to support the media in a tilted orientation directed away from the vertical surface.

Neither Silverbrook '430, Miyamoto nor Silverbrook '349, alone or in combination, disclose or suggest the media processing device having a support configured to couple a media processing engine of the devise to a vertical surface and a receiver which supports media in a tilted orientation directed away from the vertical surface. The Office Action acknowledges that Silverbrook '430 fails to disclose a receiver configured to support media in a tilted orientation away from the vertical surface. (Office Action, p. 9 discussing Claim 51.) As a result, the Office Action attempts to additionally rely upon Silverbrook '349 which discloses tray 619.

However, Silverbrook '430 discloses a handheld mobile phone with integral internal printer in which media is discharged along its side. Tray 619 of Silverbrook '349 is configured to receive media discharged from the bottom of a printer. The Office Action has failed to cite any teaching or suggestion in either Silverbrook '430 or Silverbrook '349 as to how tray 619 would somehow be mounted to printer phone of Silverbrook '430. Moreover the Office Action has failed to cite any motivation or suggestion for even further reconfiguring tray 619 so as to support media in a tilted orientation away from a vertical surface. Thus, Applicant respectfully requests that the rejection of Claim 51 be withdrawn for this additional reason. Claim 52 depends

from Claim 51 and is believed to be patentably distinct over Silverbrook '430, Miyamoto and Silverbrook '349 for the same reasons.

B. Claims 55 and 60.

Claim 55 depends from Claim 29 and recites that the media input is configured to receive an individual sheet of media from a stack of media positioned proximate to the input. Claim 60 depends from Claim 59 and includes positioning a stack of individual sheets of media proximate to media input.

As acknowledged in the Office Action, neither Silverbrook '430 nor Miyamoto disclose a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. As a result, the Office Action attempts to additionally rely upon Silverbrook '349 and asserts that Silverbrook '349 discloses a media input configured to receive an individual sheet of media from a stack of media positioned proximate to the input. (Office Action, p. 10 – discussing Claim 55.)

However, media tray 607 disclosed by Silverbrook '349 is internally located within printer 601. Nowhere does Silverbrook '349 or Silverbrook '430 provide any teaching, suggestion or even motivation for somehow modifying the handheld mobile phone of Silverbrook '430 to include an internal print tray such as tray 607 of Silverbrook '349. Moreover, to somehow add an internal print tray 607 as disclosed by Silverbrook '349 would seemingly destroy the intended purpose of Silverbrook '430 to provide a handheld mobile phone. In addition, since the mobile phone of Silverbrook '430 feeds media in a horizontal side-to-side fashion, it would not be possible to add an internal printer tray such as printer tray 607 of Silverbrook '349 without requiring a complete reconstruction of the mobile phone of Silverbrook '430. In rejecting Claim 55, the Office Action appears to be selectively picking and choosing features from different patents and hodgepodging such features together to read on the device recited in Claim 55. This piecemeal hodgepodge of parts appears to be using Applicant's own disclosure as a blueprint. Thus, Applicant respectfully requests that the rejection of Claims 55 and 60 be withdrawn.

VI. Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

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